

REMARKS

This Amendment is filed in response to the Office Action dated August 17, 2005. For the following reasons this application should be allowed and the case passed to issue. No new matter is introduced by this amendment. The amendment to claim 1 is supported throughout the specification and further clarifies the scope of claim 1.

Claims 1-3 are pending in this application. Claims 1-3 have been rejected. Claim 1 has been amended.

Inventor Name Change

The name of the inventor of the instant application, Yukio Fujii, has changed to Yukio Matsubara. A petition under 37 C.F.R. § 1.182 was filed on September 1, 2004, requesting that the inventor's name be changed to Yukio Matsubara. In addition, a Substitute Declaration executed by Yukio Matsubara was also filed September 1, 2004, and a declarations under 37 C.F.R. § 1.132 was filed by the inventor. However, the inventor is still incorrectly listed as Yukio Fujii by the United States Patent and Trademark Office (USPTO). Applicants respectfully request that the USPTO grant the petition under 37 C.F.R. § 1.182 and change inventor Yukio Fujii to Yukio Matsubara in this application.

Claim Rejections Under 35 U.S.C. § 102

Claims 1-3 are rejected under 35 U.S.C. § 102(b) as being anticipated by Obara et al. (U.S. Patent No. 5,843,369).

Claims 1-3 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Fukumoto et al. (U.S. Patent No. 5,780,165).

These rejections are traversed, and reconsideration and withdrawal thereof respectfully requested. The following is a comparison between the instant invention as claimed and the cited prior art.

An aspect of the invention, per claim 1, is a rolling bearing ring of a constant velocity joint, employing steel of a component composition consisting essentially of, as alloying elements, at least 0.5 mass % and 0.7 mass % at most of carbon, at least 0.5 mass % and 1.0 mass % at most of silicon, and at least 0.5 mass % and 1.0 mass % at most of manganese with a remainder of iron and inevitable impurities. The rolling bearing ring has a structure in which a raceway surface is subjected to induction hardening.

The Examiner asserted that Obara et al. and Fukumoto et al. disclose a rolling bearing ring of a constant velocity joint comprising the claimed steel composition.

Obara et al. and Fukumoto et al., however, do not disclose the steel composition required by claim 1. As acknowledged by the Examiner, "consisting essentially of" renders the claim open only for the inclusion of unspecified elements which do not materially affect the basic characteristics of the claimed subject matter. As disclosed by Obara et al., the addition of 10.5 to 13.5 % chromium provides stainless steel. Fukumoto et al. disclose that the addition of 3.5 to 7.0 % chromium keeps the quenching capability of the matrix, promotes the solid solution of carbide into the matrix, provides high hardness of the carburized surface, and maintains the thermal resistance of high-speed tool steel after carburization. Thus, the additional chromium in the percentages disclosed by Obara et al. and Fukumoto et al. clearly affects the basic characteristics of the steel. Therefore, claim 1 clearly excludes the 10.5 % to 13.5 % of Cr required by Obara et al. and the 3.5 % to 7.0 % of Cr, required by Fukumoto et al.

Claim 1 is further distinguishable over Fukumoto et al. because Fukumoto do not disclose the claimed steel composition of at least 0.5 mass % of carbon. Fukumoto et al. disclose a composition containing a maximum of 0.4 % carbon, not the at least 0.5 % carbon, as required by claim 1.

The factual determination of lack of novelty under 35 U.S.C. § 102 requires the disclosure in a single reference of each element of a claimed invention. *Helifix Ltd. v. Blok-Lok Ltd.*, 208 F.3d 1339, 54 USPQ2d 1299 (Fed. Cir. 2000); *Electro Medical Systems S.A. v. Cooper Life Sciences, Inc.*, 34 F.3d 1048, 32 USPQ2d 1017 (Fed. Cir. 1994); *Hoover Group, Inc. v. Custom Metalcraft, Inc.*, 66 F.3d 399, 36 USPQ2d 1101 (Fed. Cir. 1995); *Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992); *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051 (Fed. Cir. 1987). Because Obara et al. and Fukumoto et al. do not disclose the steel composition, as required by claim 1, Obara et al. and Fukumoto et al. do not anticipate claim 1.

Applicant further submits that Obara et al. and Fukumoto et al., whether taken alone, or in combination, do not suggest the claimed rolling bearing ring of a constant velocity joint.

Dependent claims 2 and 3 are allowable for at least the same reasons as independent claim 1 and further distinguish the claimed invention.

In light of the above Amendment and Remarks, this application should be allowed and the case passed to issue. If there are any questions regarding these remarks or the application in general, a telephone call to the undersigned would be appreciated to expedite prosecution of the application.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper,

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including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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